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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,715	04/08/2005	Brian Ellis	608-454	7314
23117 7590 02/07/2008 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			EXAMINER OH, TAYLOR V	
			ART UNIT 1625	PAPER NUMBER
			MAIL DATE 02/07/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/530,715

Applicant(s)

ELLIS, BRIAN

Examiner

Taylor Victor Oh

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 10 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>4/05</u> . | 6) <input type="checkbox"/> Other: _____ |

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The Status of Claims:

Claims 1-11 are pending.

Claims 1-9 are rejected.

Claims 10-11 are withdrawn from consideration.

DETAILED ACTION

Priority

1. It is noted that this application is a371 of PCT/GB03/04060 (09/23/03), which has a foreign priority document, United Kingdom 0223681.8 (10/10/2002) ,which is not in the file.

Drawings

2. None.

Election/Restrictions

Applicant's election with traverse of Group I (claims 1-9) on 01/07/08 is acknowledged.

Claims 10-11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected groups II, there being no allowable generic or linking claim.

Applicants argue the following issue:

1. Group II depends from Claim 1 (Group I) and thus contain all the limitations of Group I; therefore, no new search is required by the examiner for the remaining groups.

With respect to applicants' arguments, regardless of the Group II depending on Group I, Group I and Groups II still lack a special technical feature between them. In the instant case, the invention of Group I is directed to the catalyst composition comprising MOaWbAuCVdNbeYf(I) for the oxidation of ethane and/or ethylene to acetic acid, whereas the invention of Group II is directed to the process for the selective production of acetic acid from a gaseous mixture containing ethane and/or ethylene.

However, the same final acetic acid can be produced by using the different catalyst composition unlike the invention of group I as shown in McCain, Jr. et al (US 5,162,578), which describes that the acetic acid is obtained from the catalytic oxidation of ethane or ethylene in contact with a mixed catalyst composition : MoxVyZz. Thus, there is no single general inventive concept and no unity of invention for the method or the process as defined in 37 CFR 1.475.

Therefore, there is no single general inventive concept and no unity of invention

between the method of producing acetic acid and the catalyst composition as defined in 37 CFR 1.475.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated clearly by Ellis et al (EP 1043064).

Ellis et al discloses the followings (see pages 2-3, paragraphs 0011-0012):

[0011] Accordingly, the present invention provides a catalyst composition for the oxidation of ethane to ethylene and/or acetic acid and/or for the oxidation of ethylene to acetic acid which composition comprises in combination with oxygen the elements molybdenum, vanadium, niobium and gold in the absence of palladium according to the empirical formula: $\text{Mo}_a\text{W}_b\text{Au}_c\text{V}_d\text{Nb}_e\text{Y}_f$ (I) wherein Y is one or more elements selected from the group consisting of: Cr, Mn, Ta, Ti, B, Al, Ga, In, Pt, Zn, Cd, Bi, Ce, Co, Rh, Ir, Cu, Ag, Fe, Ru, Os, K, Rb, Cs, Mg, Ca, Sr, Ba, Zr, Hf, Ni, P, Pb, Sb, Si, Sn, Tl, U, Re, Te, La and Pd; a, b, c, d, e and f represent the gram atom ratios of the elements such that :

$$0 < a \leq 1; 0 \leq b < 1 \text{ and } a + b = 1;$$

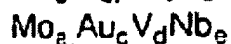
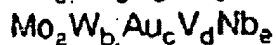
$$10^{-5} < c \leq 0.02;$$

$$0 < d \leq 2;$$

$$0 < e \leq 1; \text{ and}$$

$$0 \leq f \leq 2.$$

[0012] Catalysts embraced within the formula (I) include:-



Furthermore, the specific ratios of Mo, V, Nb, Au, and O are inherently present within those specific ratios of the prior art catalyst composition containing Mo, V, Nb, Au, and O. Therefore, they are identical with the claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


TAYLOR VICTOR OH
PRIMARY EXAMINER

2/3/08